

ESTTA Tracking number: **ESTTA420941**

Filing date: **07/20/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	George A. Powell
Granted to Date of previous extension	07/20/2011
Address	c/o Koenig & Associates 920 Garden Street Santa Barbara, CA 93101 UNITED STATES
Party who filed Extension of time to oppose	Mr.GeorgeA.Powell
Relationship to party who filed Extension of time to oppose	Spaces

Attorney information	Kurt Koenig Koenig & Associates 920 Garden Street Santa Barbara, CA 93101 UNITED STATES Kurt@incip.com Phone:805-965-4400
----------------------	--

Applicant Information

Application No	85145920	Publication date	03/22/2011
Opposition Filing Date	07/20/2011	Opposition Period Ends	07/20/2011
Applicant	Just Bones Boardwear Limited Liability Company 17 Clive Hills Road Short Hills, NJ 07078 UNITED STATES		

Goods/Services Affected by Opposition

Class 025.


All goods and services in the class are opposed, namely: swimwear, T-shirts, sweatshirts, flip flops, baseball caps


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1091899	Application Date	09/01/1977
Registration Date	05/23/1978	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1977/07/05 First Use In Commerce: 1977/07/05 WHEELS FOR SPORTING ARTICLES-NAMELY, WHEELS FOR SKATEBOARDS		

U.S. Registration No.	1501450	Application Date	12/23/1987
Registration Date	08/23/1988	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1977/07/00 First Use In Commerce: 1979/06/00 SPORTING GOODS, NAMELY SKATE BOARDS AND PARTS THEREFOR; AND WHEELS FOR ROLLER SKATES		

U.S. Registration No.	1559066	Application Date	12/23/1987
Registration Date	10/03/1989	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of	NONE		


Mark	
Goods/Services	Class 025. First use: First Use: 1977/06/00 First Use In Commerce: 1977/06/00 PROMOTIONAL CLOTHING, NAMELY SWEATSHIRTS AND T-SHIRTS

U.S. Registration No.	1695119	Application Date	05/07/1990
Registration Date	06/16/1992	Foreign Priority Date	NONE
Word Mark	BONES BRIGADE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1981/03/00 First Use In Commerce: 1981/03/00 indicating membership in an organization of skateboarding enthusiasts		

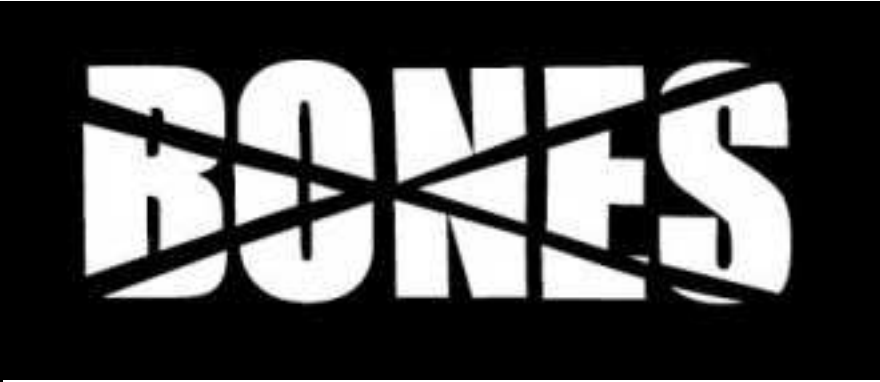
U.S. Registration No.	1705475	Application Date	05/07/1990
Registration Date	08/04/1992	Foreign Priority Date	NONE
Word Mark	BONES BRIGADE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1979/06/00 First Use In Commerce: 1979/06/00 entertainment services; namely, conducting professional skateboarding team competitions and exhibitions		

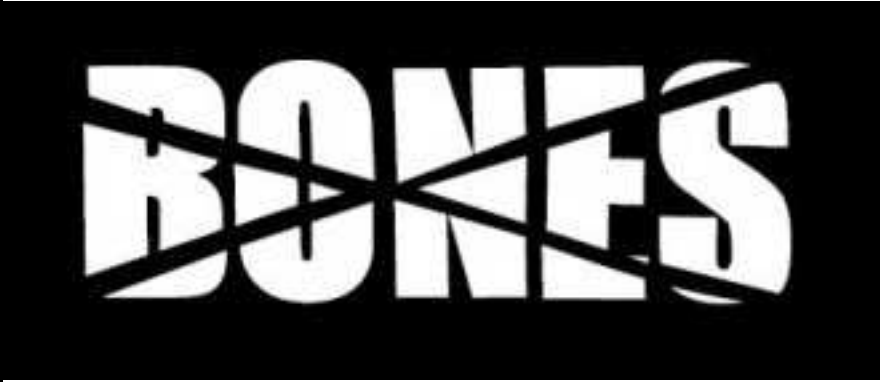
U.S. Registration No.	2553383	Application Date	08/23/1999
Registration Date	03/26/2002	Foreign Priority Date	NONE

Word Mark	HARDCORE BONES
Design Mark	HARDCORE BONES
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 2000/07/12 First Use In Commerce: 2000/07/12 SPORTING GOODS, NAMELY SKATEBOARDS AND PARTS THEREFOR, SKATEBOARD WHEELS, AND WHEEL BUSHINGS

U.S. Registration No.	3061458	Application Date	11/16/2001
Registration Date	02/28/2006	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/06/30 First Use In Commerce: 1977/06/30 Clothing, namely, hats, shirts, jackets, sweat shirts and belts		

U.S. Registration No.	3810594	Application Date	11/10/2009
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	BONES		

Design Mark	
Description of Mark	The mark consists of The word "BONES" centered in a rectangular box with two lines in the shape of an "X" or cross through the letters.
Goods/Services	Class 028. First use: First Use: 2006/09/01 First Use In Commerce: 2006/09/01 Skateboard wheels, Skateboard bushings, Skateboard riser pads, Skateboard wax, Skateboard grip tapes, Skateboard hardware, namely, nuts and bolts for skateboards

U.S. Registration No.	3810792	Application Date	11/20/2009
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	The mark consists of the word "BONES" centered in a black rectangular box with two diagonal lines that form the shape of an x or a cross through the letters in the word "BONES" .		
Goods/Services	Class 025. First use: First Use: 2006/09/01 First Use In Commerce: 2006/09/01 Baseball caps; Caps; Hats; Headgear, namely, baseball caps, beanies, and caps; Headwear; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sweat shirts; T-shirts; Tops; Wearable garments and clothing, namely, shirts		

Attachments	73703301#TMSN.gif (1 page)(bytes) 73703239#TMSN.gif (1 page)(bytes) 74056716#TMSN.gif (1 page)(bytes) 74056717#TMSN.gif (1 page)(bytes) 75782886#TMSN.gif (1 page)(bytes) 76338768#TMSN.gif (1 page)(bytes) 77869282#TMSN.jpeg (1 page)(bytes) 77878031#TMSN.jpeg (1 page)(bytes) NOO.pdf (8 pages)(134803 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kurt Koenig/
Name	Kurt Koenig
Date	07/20/2011

In the matter of Application Serial No. 85145920
For the mark: JUST BONES BOARDWEAR
Filing Date: October 6, 2010
Publication Date: March 22, 2011

[illegible]

In the matter of the application of JUST BONES BOARDWEAR LIMITED LIABILITY COMPANY, a New Jersey limited liability company, having an address of 17 Clive Hills Road, Short Hills, NJ 07078, (hereinafter "Applicant"), for registration of the trademark JUST BONES BOARDWEAR & Design ("Applicant's Mark"), as set forth in Application Serial No. 85145920, published in the *Official Gazette* of March 22, 2011, George A. Powell, an individual citizen of the United States of America having an address of 30 South La Patera Lane, Santa Barbara, California 93117 (hereinafter "Opposer"), believes he will be damaged by




Applicant's Mark in the form shown below and as it appears in Application Serial No. 85145920 and hereby opposes the same.



The grounds for opposition are as follows:

1. Opposer, for many years and long prior to any date of first use upon which Applicant can rely, has continuously used, licensed, manufactured, sold, distributed, and advertised in interstate commerce in conjunction with the mark BONES and other related marks incorporating the word BONES, for various goods and services, including apparel, skateboards, action sports apparel, and related goods and accessories, in Classes 25, 28, and 41.

2. Opposer is the owner of various trademarks and trademark registrations for the mark BONES for a variety of goods and services and has exclusive rights to the mark BONES and certain BONES & Design marks, (collectively "Opposer's Marks"), including the following registrations consisting of or incorporating the mark BONES:

<u>MARK</u>	<u>CLASS</u>	<u>GOODS/SERVICES</u>	<u>REG. NO.</u>	<u>REG. DATE</u>
BONES	028	Wheels for sporting articles - namely, wheels for skateboards.	1,091,899	05/23/1978
	028	Sporting goods, namely skate boards and parts therefor; and wheels for roller skates.	1,501,450	08/23/1988
	025	Promotional clothing, namely sweatshirts and t-shirts.	1,559,066	10/03/1989
BONES BRIGADE	200	Indicating membership in an organization of skateboarding enthusiasts.	1,695,119	06/16/1992
BONES BRIGADE	041	Entertainment services; namely, conducting professional skateboarding team competitions and exhibitions.	1,705,475	08/04/1992
HARDCORE BONES	028	Sporting goods, namely skateboards and parts therefor, skateboard wheels, and wheel bushings.	2,553,383	03/23/2002
BONES	025	Clothing, namely, hats, shirts, jackets, sweat shirts and belts	3,061,458	2/28/2006
BONES & Design 	028	Skateboard wheels, Skateboard bushings, Skateboard riser pads, Skateboard wax, Skateboard grip tapes,	3,810,594	6/29/2010

Skateboard
hardware,
namely, nuts and
bolts for
skateboards

BONES & Design 025 Baseball caps; 3,810,792 6/29/2010



Caps; Hats;
Headgear,
namely, baseball
caps, beanies,
and caps;
Headwear;
Shirts; Shirts
and short-
sleeved shirts;
Short-sleeved or
long-sleeved t-
shirts; Short-
sleeved shirts;
Sweat shirts; T-
shirts; Tops;
Wearable
garments and
clothing,
namely, shirts

Each of Opposer's Marks is valid and subsisting and is conclusive evidence of Opposer's exclusive right to use Opposer's Marks on the goods and services identified in the registrations. Furthermore, certain of the above-noted registered Marks are now incontestable under 15 U.S.C. §1065. Opposer's Marks are arbitrary and strong and because Opposer has licensed and used the mark BONES and related marks continuously in connection with apparel and related accessories in Class 25, long before Applicant's filing date or use of the applied for mark, Opposer is entitled to protection of his distinctive marks.

3. Opposer's apparel and skateboard goods have been offered and advertised continuously to the public throughout the

United States through various channels of trade in conjunction with Opposer's Marks since at least as early as June 1977. By reason of such advertising and wide distribution of Opposer's goods and services, the public recognizes the mark BONES and variations thereof as signifying the goods and services offered by Opposer. Additionally, Opposer has built extensive goodwill in connection with Opposer's Marks.

4. Opposer also uses the word BONES in conjunction with various "bones design" marks, such as skulls with bone designs, and such designs appear both alone and with the word BONES in such a way that they separately create a visual image in the mind of the consumer of the term "BONES" and Opposer is widely known for the goods sold under such "bones design" marks.

5. Notwithstanding Opposer's exclusive prior rights in and to the trademarks incorporating the term BONES, Applicant, on October 6, 2010, filed an application to register the trademark JUST BONES BOARDWEAR & Design in the following form:



in Class 25 for "*swimwear, T-shirts, sweatshirts, flip flops, baseball caps.*" Said application was assigned Serial No.

85145920 and the mark was published for opposition in the *Official Gazette* of March 22, 2011.

6. The mark JUST BONES BOARDWEAR & Design, which Applicant seeks to register, so resembles Opposer's Marks that the registration of Applicant's Mark and any use by Applicant of Applicant's Mark is likely, when applied to the goods identified in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, all to Opposer's damage.

7. As alleged herein, Opposer is the owner of a number of trademarks and federal trademark registrations for the mark BONES, including those registrations identified in paragraph 2 of this Notice of Opposition.

8. Opposer's BONES mark is famous with strong and distinctive character qualifying the trademark for protection under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), as amended.

9. Application Serial No. 85145920 was filed on October 6, 2010 and therefore is subject to the provisions of Section 43(c) of the Lanham Act, as amended.

10. Opposer avers that Applicant's proposed use of said trademark is confusingly similar to Opposer's Marks, is likely to cause confusion with Opposer's trademarks and dilute the distinctiveness of the BONES trademark and services mark and thus interferes with Opposer's use of said marks. Opposer

believes that the registration of Applicant's Mark in Class 25 will seriously and substantially damage Opposer in violation of Section 43(c) of the Lanham Act, as amended.


WHEREFORE, Opposer believes he will be damaged by said registration and requests that Application Serial No. 85145920 for the mark JUST BONES BOARDWEAR be denied on the grounds set forth herein and that this Opposition be sustained.

This Notice of Opposition is submitted via ESTTA along with the filing fee in the amount of \$300.

Respectfully submitted,

Dated: July 20, 2011


By:


Kurt Koehnig
920 Garden St., Suite A
Santa Barbara, CA 93101
Tel: 805-965-4400
Fax: 805-564-8262

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office via ESTTA with the required fees on the date identified below.

Dated: July 20, 2011


Kurt Koehnig

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing "NOTICE OF OPPOSITION" was served on July 20, 2011 by first-class mail, postage prepaid, to Applicant's counsel addressed as follows:

Ms. Melanie C. Holloway
Leading Edge Law Group, PLC
1031 E. Cary St., Suite 1130
Richmond, VA 23219-4023

Dated: July 20, 2011



Kurt Koenig
